

REMARKS

Applicants appreciate the indication that Claim 5 is in condition for allowance. Applicants have rewritten Claim 5 in independent form including all of the limitations found in the base claim.

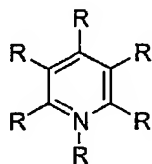
Claims 5 and 12 have been amended, leaving Claims 1-12 for further consideration in the present amendment. It is believed that the amendments made herein may be properly entered at this time, i.e., after final rejection, because the amendments do not require a new search or raise new issues and reduce issues for appeal. In particular, the claims as amended are believed to recite subject matter indicated as allowable in the Final Office Action. No new matter has been introduced by these amendments.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(e)

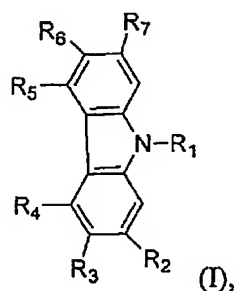
Claims 1-4 and 6-12 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by US Patent Publication No. 2003/0205696 to Thoms et al. (hereinafter Thoms). Applicants respectfully traverse this rejection.

In repeating this rejection, the Examiner first comments that paragraph [0012] discloses that the host is a carbazole based compound having the following structure:



However, this is incorrect. Rather, paragraph [0012] provides structure (I) below:

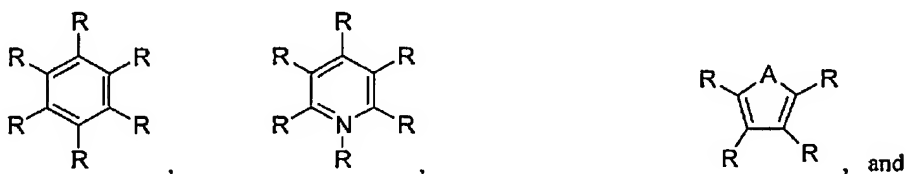
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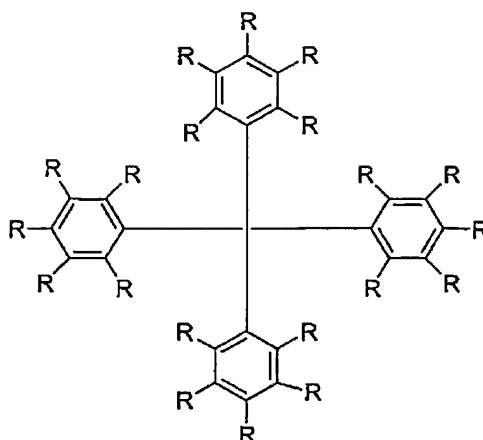
Paragraph [0013] provides further definition of the various R substituents: “[w]herein R₁ is an alkyl or aromatic electron donating moiety, and at least one of R₂ through R₇ is an aromatic amine or carbazole having transport capability, and the guest is a light emissive compound having a smaller band gap potential than the host.” The above noted structure (I) can be characterized as a carbazole core with hole transporting carbazole or arylamine moieties bonded thereto. There is no disclosure that the compounds do not have an axis of symmetry.

The Examiner also refers to paragraph [0061] as providing support that if at least two R_s are carbazoles or substituted carbazoles, then there would be no axis of symmetry. Paragraph [0061] of Thoms is reproduced below:

[0061] Host materials compounds having small, electron rich-core with carbazole groups attached thereto may be represented by the following formulae:



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According to Thoms, at least two of the R groups are carbazole or substituted carbazole. The Examiner comments that when there are three R's that are substituted in the 2, 3 and 6 positions of the aromatic moiety, there is no axis of symmetry. However, there is no support for providing substitution in those positions so as to provide a compound without an axis of symmetry.

In order to support an anticipation rejection, a piece of prior art must clearly and unequivocally disclose the claimed composition or direct those skilled in the art to the composition without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *In re Arkley*, 59 CCPA 804, 455 F.2d 586, *Air Products & Chemicals, Inc. v. Chas. S. Tanner Co.* 219 USPQ 223, *Perricone v. Medicis Pharmaceutical Corp.*, 267 F.Supp.2d 229. Thoms fails to satisfy this burden. There is no disclosure that any of the compounds disclosed therein lack an axis of symmetry as we have claimed. Those compounds that are explicitly detailed either do not fall within the formula set forth in our claim or possess more than one axis of symmetry. Thoms does not direct one skilled in the art to choose compounds without an axis of symmetry over those that do have one or more axes of symmetries. There are hundreds of possible compounds provided in Thoms. One of ordinary skill in the art has no direction from Thoms to select compounds falling within the scope of our claims and without an axis of symmetry from among the hundreds of different possible compounds.

Moreover, it should be noted that anticipation by inherency only happens if the

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anticipating elements (1) are necessarily present and (2) one of ordinary skill in the art recognize or appreciate the inherent element. See, e.g., *Galaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1046 (Fed. Cir. 1995). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can Co. v. Monsanto*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Furthermore, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)" MPEP 2112. In the present case, those compounds that are disclosed in Thoms that read on Applicants' claimed formula are those having multiple axes of symmetry. On of ordinary skill in the art would fail to appreciate the use of compounds as claimed by Applicants that do not have an axis of symmetry.

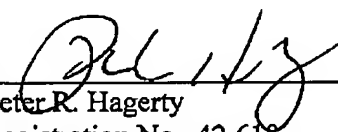
In view of the foregoing, the rejection is improper and should be withdrawn for at least these reasons.

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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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